



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW CA 94041

COPY MAILED

NOV 18 2004

OFFICE OF PETITIONS

In re Application of
G. Scott Herron
Application No. 09/905,704
Filed: February 27, 2001
Attorney Docket No. 464363000300

:
: DECISION ON PETITIONS
: UNDER 37 CFR 1.78(a)(3) AND
: UNDER 37 CFR 1.78(a)(6)
:

This is a decision on the petition under 37 CFR § 1.55(a), filed February 25, 2004, which is being treated as a petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §§ 120, 365(c) and 119(e) for the benefit of prior-filed applications.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition fails to comply with item (1) above.

37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or provisional

applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications.

It appears that petitioner attempted to include an amendment, containing a reference to each prior-filed application, in the body of the petition. However, petitioner failed to comply with the requirements of 37 CFR §§ 1.78(a)(2)(iii) and 1.78(a)(5)(iii).

Accordingly, before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) and an amendment¹ or an Application Data Sheet, containing a reference to each prior-filed application(s) is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, Va 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: 2011 South Clark Place
 Crystal Plaza Two Lobby
 Room 1B03
 Arlington, VA 22202

Any questions concerning this matter may be directed to Petitions Attorney Christina Tartera Donnell at (571) 272-3211.


Frances Hicks

Lead Paralegal
Office of Petitions
Office of the Deputy Commission
for Patent Examination Policy

¹ Note 37 CFR 1.121 and 37 CFR 1.4(c).